

**REMARKS**

The Examiner has rejected claims 1-7 and 9-10 under 35 U.S.C. §102 as being anticipated by U.S. Patent No. 3,685,176 to Rudy ("Rudy"). Based on the foregoing amendments and following remarks, Applicant submits that Rudy does not disclose, teach, or suggest Applicant's claimed invention and that the rejections should be withdrawn.

Applicant's invention in claim 1 requires a vamp of an upper extending from a toe region to an instep region and consisting essentially of a single and continuous unit; a liner positioned beneath the instep portion and consisting of a single and continuous piece; and an elastic instep guard positioned between the instep portion and the liner.

Due to Applicant's single and continuous vamp and liner, the claimed instep protector provides a simpler shoe construction having fewer pieces and material than Rudy, which requires additional and more complex pieces, such as a split upper and a split liner (figure 6). "The front portions of the collar and foot portion are split..." Col. 3, lines 33-35. Hence, Rudy cannot anticipate Applicant's continuous vamp extending from a toe region to an instep region because Rudy's upper, in the area that extends from the toe to the instep, is split into two pieces and cannot be a single or continuous unit.

Similarly, Rudy's liner is not disclosed, taught, or suggested to be a single and continuous unit. Moreover, the liner shown in figure 6 is split into two pieces and, therefore, cannot anticipate Applicant's liner.

Because all elements of Applicant's claim 1 are not disclosed by Rudy, the rejections should be withdrawn.

The Examiner has rejected claims 10 and 24 under 35 U.S.C. §103(a) as being unpatentable over Rudy in view of U.S. Patent No. 2,988,829 to Johnsen ("Johnsen"). Based on the foregoing amendments and following remarks, Applicant submits that claims 10 and 24 are allowable.

Applicant's claim 24 requires the following: a vamp of an upper extending from a toe portion to an instep portion; a liner positioned beneath the instep portion; a steel toe positioned beneath the toe portion; an elastic guard positioned between the instep portion and the liner and including a plurality of hollow passages; and the elastic instep guard is in contact with the steel toe and extends from the steel toe toward the instep portion for providing continuous protection to the foot.

Rudy does not, and the Examiner agrees in his Office Action, disclose, teach, or suggest a steel toe or a guard in contact with the steel toe. Applicant submits that Johnsen also does not disclose, teach, or suggest an elastic guard or that the elastic guard is between the instep portion and the liner and that the guard is also in contact with the steel toe.

Johnsen requires the guard to be of a steel or rigid material and does not teach or suggest an elastic guard. Moreover, Johnsen's guard is not in contact with the steel toe, as required by Applicant's claim 24, because insert 35 is between the steel toe and safety pad 30, shown in Johnsen's figure 4. "An insert 35...is interleaved between the metal cap assembly comprising the metal cap 21...an the outer portion assembly

comprising...pad 30." Col. 2, lines 35-40. Hence, Johnsen does not teach or suggest an elastic instep guard in contact with the steel toe and extending from the steel toe toward the instep portion for providing continuous protection to the foot.

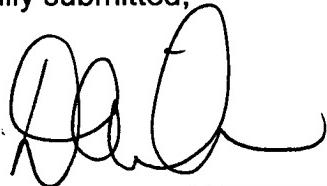
Even a combination of Rudy and Johnsen would not provide Applicant's invention. Instead, one would arrive at an instep protector having a guard between a split upper and a split liner where an insert is placed between the guard and a steel toe. Therefore, Rudy and Johnsen do not render Applicant's invention obvious absent modifications.

Applicant respectfully submits that modifying Rudy or Johnsen to arrive at Applicant's invention would not be proper. Before a modification of a reference can be made in a rejection under 35 U.S.C. §103, some motivation for the artisan to make the modification must be shown. None of the references provide any reason or logic for an elastic instep guard in contact with a steel toe and extending from the steel toe toward the instep portion for providing continuous protection to the foot. The person of ordinary skill in the art does not have the current application in front of him/her when considering modifications. Modifying the references to arrive at the claimed invention is even more unlikely given that Rudy teaches that its bladder deflates under pressure and, therefore, cannot possibly be a protective device to resist impact, as Applicant's invention provides. "During skiing operations, however, fore and aft movements of the leg about the ankle joint as a pivot can produce sufficient deformation of the tubes above the ankle..." (col. 6, lines 59-64). Hence, there is no reason why one skilled in the art would modify the prior art to arrive at the claimed invention.

Application No. 09/686,546  
Applicant: Charles E. Covatch  
Page 6

For the foregoing reasons, Applicant respectfully submits that all pending claims are patentable over the references of record.

Respectfully submitted,



---

Gene S. Winter, Registration No. 28,352  
David Chen, Registration No. 46,613  
ST. ONGE STEWARD JOHNSTON & REENS LLC  
986 Bedford Street  
Stamford, Connecticut 06905-5619  
(203) 324-6155  
Attorneys for Applicants